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WILLIAM H BOLLMAN
FARKAS & MANELLI PLLC
2000 M STREET N W
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER
LY, NGHI H

ART UNIT	PAPER NUMBER
2682	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/447,284	Applicant(s) CAO ET AL.	
	Examiner Nghi H. Ly	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Borland (US 6,343,217).

Regarding claim 1, Borland teaches a cordless telephone (see abstract), comprising: a remote handset (see fig.1 handset 110), a base unit matched to the remote handset (see fig.1 base station 120) and a digital audio bit stream player integrated within at least one of the remote handset and the base unit (see column 1 line 6-9, and see column line 60-64).

Regarding claim 2, Borland teaches the digital audio bit stream player is integrated within the remote handset (see column 3 line 1-6).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3-8, 11-18, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) over in view of Mills et al (US 6,353,870).

Regarding claim 3, 4 and 5, Borland teaches the cordless telephone according to claim 1. Borland does not specifically disclose the digital audio bit stream player is an MPEG audio player: specifically not a MP3 player. Mills teaches the digital audio bit stream player is an MP3 audio player (see column 8 line 2-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

provide the teaching of Mills into the system of Borland so that more audio data could have been stored in a more compact device for listener.

Regarding claims 6 and 18, Borland teaches a method of integrating a digital bit stream music player in a cordless telephone (see abstract). Borland does not specifically disclose a method comprising: playing MP3 music from a remote handset of a cordless telephone. Mills teaches playing MP3 music from a remote handset of a cordless telephone (see column 8 line 2-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mills into the system of Borland so that user could have been enjoyed listening to music.

Regarding claim 7, the combination of Borland and Mills teaches claim 6 and the MP3 music is pre-loaded before the step of playing (also see Mills column 8 line 2-8).

Regarding claim 8, the combination of Borland and Mills teaches claim 7 and the MP3 music is played substantially real-time as it is received by the cordless telephone (see Mills column 8 line 8-12).

Regarding claims 11 and 21, Borland teaches downloading digital bit stream music to the remote handset from a remote bit stream audio source (see column 2 line 11-28).

Regarding claims 12 and 22, Borland teaches storing the downloaded digital bit stream music in a base unit of the cordless telephone (see column 3 line 42-49).

Regarding claims 13 and 23, Borland teaches claim 11. Borland does not specifically disclose storing the downloaded digital bit stream music in the remote

handset of the cordless telephone. Mills teaches storing the downloaded digital bit stream music in the remote handset of the cordless telephone (see column 8 line 2-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mills into the system of Borland so that music could have been selected and replayed more conveniently.

Regarding claims 14 and 24, Borland teaches claim 6. Borland does not specifically disclose the downloaded digital bit stream music is stored in Flash memory in the remote handset. Mills teaches the downloaded digital bit stream music is stored in Flash memory in the remote handset (see column 6 line 25-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mills into the system of Borland so that audio data could have been stored in nonvolatile form.

Regarding claims 15 and 25, Borland teaches claim 11. Borland does not specifically disclose the remote bit stream audio source is accessible by the remote handset via an Internet. Mills teaches the remote bit stream audio source is accessible by the remote handset via an Internet (see column 14 line 43-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mills into the system of Borland so that user could have been enjoyed music from the public network.

Regarding claims 16 and 26, Borland teaches claim 11. Borland does not specifically disclose the digital bit stream music is comprised in an MPEG format. Mills teaches the digital bit stream music is comprised in an MPEG format (see column 8 line

2-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mills into the system of Borland so that more audio data could have been stored for listener.

Regarding claims 17 and 27, the combination of Borland and Mills teaches claim 16 and the MPEG format is an MP3 format (see Mills column 8 line 2-7).

6. Claims 9, 10, 19, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (US 6,343,217) over in view of Mills et al (US 6,353,870) and further in view of Abecassis (US 6,192,340).

Regarding claims 9 and 19, the combination of Borland and Mills teaches claim 6. The combination of Boland and Mills does not specifically disclose muting the playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call. Abecassis teaches muting the playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call (see fig.2 "mute" button). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Abecassis into the system of Mills and Borland so that music could have been stopped while listener having conversation on the phone.

Regarding claims 10 and 20, the combination of Borland, Mills, and Abecassis teaches claims 8 and 9, and muting pauses the playing of the pre-loaded MP3 music (see Abecassis fig.2 "mute" button, also see column 5 line 39-42).

Regarding claim 28, Borland teaches claim 21. Borland does not specifically disclose compressing MPEG formatted music into digital music samples for digital to

analog output. Abecassis teaches compressing MPEG formatted music into digital music samples for digital to analog output (see column 7 line 23-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Abecassis into the system of Borland so that listener can enjoy listening to music while speaking on the phone.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Lehtinen (US 6,172,673) teaches multimedia terminal and method for realizing multimedia reception.

b. Kim (US 6,083,009) teaches karaoke service method and system by telecommunication system.

c. Birrell (US 6,332,175) teaches low power system and method dor playing compressed audio data.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly

March 25, 2002

VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

3/25/02